

REMARKS

Claims 1-24 are pending in the application.

Claims 1-24 have been rejected.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0068721 to *O'Neill et al.*, hereinafter "O'Neill" in view of U.S. Patent Publication No. 2007/0142083 to *Cupps et al.*, hereinafter "Cupps". The Applicant respectfully traverses the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some

rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *Id.*

Claim 1 describes

1. (Original) A wireless communication device capable of accessing a wireless network and downloading a software upgrade file therefrom, said wireless communication device comprising:
 - a first central processing unit (CPU) capable of controlling wireless communications with said wireless network;
 - a first memory associated with said first CPU;
 - a second central processing unit (CPU) capable of executing at least one end-user application on said wireless communication device; and
 - a second memory associated with said second CPU,

wherein said first CPU downloads said software upgrade file from said wireless network and stores said downloaded software upgrade file in said second memory.

As discussed at length in previous responses, Claim 1 clearly requires a wireless communication device having two CPUs, where the first CPU can control wireless communications and the second CPU can execute an application. The first CPU downloads a software upgrade file and stores it in a memory associated with the second CPU. Claim 13 includes similar limitations. These are not taught or suggested by any art of record, alone or in combination.

The Examiner finally concedes, after forcing the Applicant to the time and expense of appeal, that O'Neill does not teach these limitations. Cupps also fails to teach or suggests a wireless communication device having two CPUs that operate as claimed.

The Examiner refers to Cupp's paragraphs 0013 and 0119, reproduced in a prior response.

The Examiner is correct that Cupps describes a handheld device with dual processors, and each of those processors is allocated a separate memory portion. Cupps can fairly be read to describe a first CPU associated with a first memory portion and a second CPU associated with a second memory portion. Cupps even describes, in paragraph 0061, an embodiment using three processors, including a phone module ARM 7 core processor that manages wireless transmissions and a mobile processor that can handle other office automation tasks, such as word processing.

Still, neither Cupps nor O'Neill, nor any combination of them, teaches or suggests that the *first* CPU downloads a software upgrade file from a wireless network and stores the downloaded

software upgrade file in *second* memory, associated with the second CPU. Nothing in Cupps or O'Neill teaches that this would be desirable or operable, or that there would be any predictable result or likelihood of success. The Examiner doesn't even address this limitation in his rejection, and the rejection is legally deficient. As Cupps specifically describes that each of its two processors is allocated its own separate memory, it appears that a processor in Cupps' system *would not be capable* of performing as described, which would require one processor to access the memory dedicated to the other processor.

In fact, Cupps describes in paragraph 0175 that "system processor 302 is self-contained, and the software applications that run within the embedded operating environment are considered 'closed.' Specifically, in a 'closed' environment, the software used is specified by the developer of the embedded system and may not be upgraded or modified by the user of the embedded operating system. In addition, no new software may be introduced to the embedded system by the user".

The Examiner's suggested "motivation" has nothing at all to do with the particular claim limitation of the first CPU downloading a software upgrade file from a wireless network and storing the downloaded software upgrade file in second memory, associated with the second CPU, as claimed. This concept is not considered at all by any combination of the references.

Applicant further notes that the relevant teachings of the O'Neill reference (hereafter O'Neill '721) do not appear to be prior art to this application. This application was filed on June 20, 2003; O'Neill was filed on July 31, 2003, more than a month later. O'Neill is a continuation-in-part of

application No. 10/311,462, filed May 13, 2003 (from a PCT filed November 18, 2001), now published as US 2003/0182414 (hereafter O'Neill '414). While O'Neill '414 clearly qualifies as 102(e) prior art to this application, the CIP O'Neill '721 is only 102(e) prior art for that subject matter supported by its parent application, O'Neill '414.

Applicant respectfully notes that the teachings on which the Examiner relies in O'Neill '721 are not supported by O'Neill '414, and are not entitled to any filing date earlier than July 31, 2003, after this application. The Examiner is invited to consider whether O'Neill '414 supports the current rejections. Applicant respectfully suggests that it does not, and so the current rejections over the new matter presented in O'Neill '721 are improper.

O'Neill '414 does not discuss a "wireless communication device" at all (using that specific language, as used in O'Neill 721, though mobile devices are certainly mentioned), and does not include the Figure 2 and related discussion on which the Examiner relies. If the Examiner were to show the subject matter in Figure 2, one which he relies, in one of the parent applications to O'Neill '721, then perhaps he could show a proper rejection, relying on an incorporation by reference. But he has not, and the rejection in its present form is flawed.

Applicant does note that O'Neill '721 references several provisional applications. Provisional 60/249,606 was also cited in O'Neill '414, and so there appears to be a proper "chain" of priority from O'Neill '721 to the '606 provisional. The '606 provisional is incorporated by reference to O'Neill '721, but is not available in public PAIR for review and so Applicant cannot comment.

O'Neill '721 also references provisional applications 60/401,054 and 60/412,850, both available on PAIR at least as of this date. These applications include some relevant teachings the Examiner may wish to consider. The Examiner is correct that O'Neill '721 incorporated these by reference, and the undersigned apologizes for the error.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

DOCKET NO. 2003.07.011.WT0
SERIAL NO. 10/600,223
PATENT

Respectfully submitted,

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Date: 12-23-08

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